

REMARKS

A. Request for Reconsideration

Applicant has carefully considered the matters raised by the Examiner in the Advisory Action but remains of the position that patentable subject matter is present. Applicant respectfully requests reconsideration of the Examiner's position based on the amendments to the claims and the following remarks.

B. Claim Status and Amendments

Claims 1, 2, 4, 5 and 7-16 are presented for further prosecution.

Claims 1 and 4 have been amended to more particularly recite that the ink of the invention is jetted from an ink jet printer. Support for these amendments can be found in paragraph 4 on page 39 of the application.

Applicant notes that the Examiner stated in the Advisory Action that "jetting" is not given patentable weight because this term is in the preamble. Applicant respectfully disagrees. Claim 4 is a method claim, which includes the method step of jetting. Thus, "jetting from an ink jet printer" as recited in method claim 4 is a method step that should be given patentable weight. Similarly, claim 1 is a product-by-process claim which

recites that the ink is "jetted...by a recording head of an ink jet printer". The ink product of claim 1 is therefore defined by the jetting process step of product-by-process claim 1. As a result, jetting from an ink jet printer as recited in claims 1 and 4 is not in the preamble, instead, it is a limitation that should be given patentable weight.

C. The Advisory Action

The Examiner continued to reject claims 1, 4 and 7-14 as being unpatentable over Chatterjee (U.S. 5,985,984) in view of Noguchi (U.S. 2002/0065335). Claims 2, 3, 5, 6, 15 and 16 were also again rejected as being unpatentable over Chatterjee in view of Noguchi and Owatari (U.S. 6,095,645).

1. The June 20, 2007 Declaration

Applicant previously submitted the June 20, 2007 Declaration to demonstrate that the composition of Example 4 of Chatterjee cannot be jetted from a recording head of an ink jet printer because the composition is too viscous. In the Advisory Action, the Examiner stated that the Declaration was not convincing because the body of the claims do not recite an ink

jet printer, and because the recitation of jetting in the claims is in the preamble and is therefore is not given patentable weight.

Applicant has amended claims 1 and 4 to more particularly recite that the ink of the invention is jetted from an ink jet printer.

As mentioned in section B above, claim 1 is a product-by-process claim which recites that the ink is "jetted...by a recording head of an ink jet printer". Thus, claim 1 specifically requires that the ink is a jetted ink. Similarly, method claim 4 positively recites the step jetting from an inkjet printer. Thus, claims 1 and 4 require that the ink is a jetted ink.

In part based on the amendments to claims 1 and 4, Applicant respectfully requests reconsideration of the June 20, 2007 Declaration. As summarized in section 7 of the Declaration, the composition of Example 4 of Chatterjee could not be jetted using an ink jet printer because the composition was too viscous. In addition, Mr. Ishikawa stated in section 8 of the Declaration that he believes that the composition of Chatterjee would not be able to be jetted from an ink jet printer, even if the polymerizable monomer and initiator of Chatterjee were replaced by the polymerizable monomer and

initiator of Noguchi. Thus, Applicant respectfully submits that the claimed invention is not obvious based on a combination of Chatterjee, Noguchi and Owatari taken alone or in combination.

In addition, Applicant has discovered that stability and image quality associated with aqueous inks for ink jet printers can be improved by including a non-ionic surfactant in an amount of 10 to 10,000 ppm as recited in claims 1 and 4. Since Chatterjee is not directed to an ink that can be jetted from an ink jet printer, one of skill in the art would not be motivated to combine the teachings of Chatterjee, Noguchi and Owatari. Applicant therefore respectfully submits that the claimed invention is not obvious based on a combination of Chatterjee, Noguchi and Owatari taken alone or in combination.

2. An aqueous ink

Claims 1 and 4 recite that the ink is an aqueous ink. Applicant previously argued that it wouldn't be obvious to combine the teachings of Chatterjee and Noguchi, because Chatterjee teaches non-aqueous compositions while Noguchi teaches aqueous-based compositions.

In the Advisory Action, the Examiner stated that Chatterjee is an "aqueous-based" ink, because the composition includes water. The Examiner therefore reasoned that it would be obvious to combine the teachings of Chatterjee and Noguchi.

Applicant respectfully disagrees with the Examiner's reading of Chatterjee. Simply because the compositions of Chatterjee can include water as an additive (see col. 7, lines 4-12), this does not mean that the compositions are "water-based". Typically, a "water-based" composition is a composition that contains a substantial amount of water. The compositions of Chatterjee do not meet this criteria. For instance, the two Tables in col. 8 of Chatterjee contain additives in an amount of 5 wt%. In the Table in col. 9, the additives are 4 wt%. In the second Table in col. 12, the additives are 1-5 wt%. Such miniscule amounts of additives, even if the additives are entirely water, cannot be said to create "water-based" compositions. Thus, those of skill in the art would not say that Chatterjee teaches water-based compositions. As a result, by adding the polymerizable compound of Noguchi to the compositions of Chatterjee, it would not be obvious to create water-based compositions.

Applicant respectfully submits that the claimed invention is not obvious based on a combination of Chatterjee, Noguchi and Owatari taken alone or in combination.

D. Extension of Time

A one-month extension of time is requested and payment is enclosed herewith.

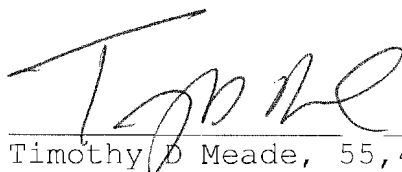
E. Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any further fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:



Timothy D Meade, 55,449
Attorney for Applicant
475 Park Avenue South
New York, NY 10016
Tel. 212-661-8000

DCL/TDM/mr

Attached: Request for Continued Examination